REMARKS

Claims 42 to 45 and 47 to 71 are pending and being considered.

Applicants respectfully request reconsideration of the present application in view of this response.

With respect to page three (3), claims 42 to 45, 47 to 53 and 61 to 71 were rejected under 35 U.S.C. § 103(a) as obvious over Kadomura, U.S. Patent No. 5,662,819 in view of Collins et al., U.S. Patent No. 6,217,785, Wilbur, U.S. Patent 6,020,794 and Koshimizu '687 U.S. Patent 5,997,687.

While the obviousness rejections may not be agreed with, to facilitate matters, claim 42 has been rewritten to provide that the oscillator is a Meissner-type.

In particular, claim 42 as presented provides that the frequency variation is carried out automatically by using a feedback loop between the IPC coil and the IPC coil generator *in the form of a Meissner oscillator*. This particular type of oscillator is explicitly disclosed in the Specification. In this context, a Meissner-type oscillator is understood to be an oscillator that includes an isolated tank circuit coupled to the input and output circuits of an amplifying device to obtain the proper feedback and frequency.

As already indicated in the earlier response, the automatic feedback loop is explained in the Specification, and is shown in Figure 2. In this context, in agreement with the above-mentioned definition of a Meissner-type oscillator, the Specification describes an oscillation and a power amplifier 3 for attaining automatic frequency adjustment.

In the "Wilbur" reference, even if a variation of frequency may occur, its method provides for powers to be compared to each other and evaluated according to an algorithm. An oscillating circuit, in particular in the form of a Meissner oscillator, as provided for in the context of claim 42 as presented, is not described and is therefore not rendered obvious by the other references.

Accordingly, claim 42 as presented is allowable (as are its dependent claims) for these reasons alone, since the other references do not cure the critical deficiencies of the other references.

As further regards the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also provide a motivation or suggestion for combining the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

Thus, the "problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem", Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). The prior art simply does not address the problems met by the subject matter of any of the rejected claims.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Final Office Action's assertions that it would have been obvious to combine the references relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Final Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

> Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

> Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .
>
> **Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is respectfully submitted that the Final Office Action reflects hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

As further regards claim 42, it relates to a method for etching a silicon body substrate using a device having an ICP source for generating a radio-frequency electromagnetic alternating field, now provides that the variation of the frequency is automatically performed

by a Meissner oscillator feedback loop between the ICP coil and the ICP coil generator input Support for this feature of claim 42 is found in the specification text relating to Figure 2.

As regards the Kadomura, Collins, and Koshimizu '687 references, these references, whether taken alone or combined, do not disclose or suggest any configuration or method where a variation in the frequency is automatically performed by a Meissner oscillator feedback loop between the ICP coil and the ICP coil generator input.

The secondary Wilbur reference does not cure the critical defects of the Kadumura, Collins, and Koshimizu '687 references. In the system of the Wilbur reference, frequency variations only occur with the aid of a sensor 16 and a processor DSP as recited in column 3, line 66 to column 4, line 25 and as illustrated in Figure 1. In Wilbur, the sensor measures the values of "reflected power" and "forward power" and transmits them to the DSP where they are analyzed according to a stored algorithm 24 and compared to earlier obtained values. In accordance with the result of the comparison, a signal for an increase or a decrease in frequency is output. The Wilbur reference therefore does not disclose or suggest a Meissner feedback oscillator or use frequency selective components and defined phase relations, since it merely indicates that outputs are compared and then analyzed according to an algorithm.

Since the references relied upon do not disclose or suggest the features of claim 42 as presented, applicants respectfully request withdrawal of the rejection to claim 42 as presented.

Claims 43 to 45, 47 to 53 and 61 to 71 depend from claim 42 as presented and therefore are allowable for the same reasons.

At page six (6), claim 60 was rejected as unpatentable under 35 U.S.C. § 103(a) over Kadomura in view of Collins, Wilbur and Koshimizu '687 as applied to claims 42 to 45, 47 to 53 and 61 to 71 and further in view of Laermer et al., U.S. Patent 5,501,893.

Claim 60 depends from claim 42 as presented and is therefore allowable for the same reasons as claim 42 as presented, since the Laermer reference does not cure the critical defects of the Kadomura, Collins, Koshimizu '687 and Wilbur references. Applicants therefore respectfully request withdrawal of the rejection of claim 60.

At page six (6), claims 42 to 45, 50 to 54, 56 to 59, 61 and 63 to 71 were rejected as unpatentable under 35 U.S.C. § 103(a) over Savas, WO 97/14177 in view of the Collins, Wilbur and Koshimizu '687 references.

As regards the Savas reference, any review of this reference makes plain that it does not disclose the features of claim 42 as presented. Also, as explained above, the other

references do not cure these deficiencies. Accordingly, it is respectfully submitted that claim 42 as presented is allowable because it includes these further features which are not disclosed by these references for essentially the reasons discussed above.

At page nine (9), claims 47 to 49, 55 and 62 were rejected as unpatentable over Savas in view of Collins, Wilbur and Koshimizu '687 as applied to claims 42 to 45, 50 to 54, 56 to 59, 61, 63 to 71, and further in view of Lymberopoulos et. al., U.S. Patent 6,085,688.

Claims 47 to 49, 55 and 62 depend from claim 42 as presented, and are therefore allowable for the same reasons as claim 42 as presented, since the Lymberopoulous reference does not cure the critical defects of the Savas, Collins, Koshimizu and Wilbur references, as explained above. Applicants therefore respectfully request withdrawal of the rejections of claim 47 to 49, 55 and 62.

At page ten (10), claim 60 was rejected as unpatentable over Savas in view of Collins Wilbur and Koshimizu '687 as applied to claims 42 to 45, 50 to 54, 56 to 59, 61 and 63 to 71, and further in view of the Laermer reference.

Claim 60 depends from claim 42 as presented and is therefore allowable for the same reasons as claim 42 above, since the Laermer reference does not cure the critical defects of the Savas, Collins, Koshimizu '687 and Wilbur references. Applicants therefore respectfully request withdrawal of the rejection of claim 60.

At page eleven (11), claims 42 to 45, 50 to 53, 56 to 59, 61 and 63 to 71 were rejected as unpatentable under 35 U.S.C. § 103(a) as unpatentable over Koshimizu '373, U.S. Patent 5,935,373 in view of Collins, Wilbur and Koshimizu '687.

The primary Koshimizu '373 reference does not disclose or suggest any configuration or method in which the frequency is automatically performed by a Meissner oscillator feedback loop between the ICP coil and the ICP coil generator input, as provided for in claim 42 as presented. As explained above, the Collins, Wilbur and Koshimizu '687 references do not disclose or suggest any method or configuration wherein the variation of the frequency is automatically performed by a Meissner oscillator feedback loop between the ICP coil and the ICP coil generator input. As the combination of references does not disclose or suggest the features of claim 42 as presented, Applicants respectfully request withdrawal of the rejection of claim 42.

Claims 43 to 45, 50 to 53, 56 to 59, 61 and 63 to 71 depend from claim 42 and are therefore allowable for the same reasons as claim 42 as presented.

At page fourteen (14), claims 47 to 49, 54, 55 and 62 were rejected as unpatentable under 35 U.S.C. § 103(a) over Koshimizu '373 in view of Collins, Wilbur, and Koshimizu '687 as applied to claims 42 to 45, 50 to 53, 56 to 59, 61 and 63 to 71, and in further view of the Lymberopoulos reference.

Claims 47 to 49, 54, 55 and 62 depend from claim 42, and are therefore allowable for the same reasons as claim 42 as presented, since the fourth-level "Lymberopoulos" reference does not cure the critical deficiencies of the primary, secondary and third-level references, nor does it provide the motivation to combine the references so as to provide the claimed subject matter of claim 42 and its resulting benefits. Applicants therefore respectfully request withdrawal of the rejection of claims 47 to 49, 54, 55 and 62.

At page sixteen (16), claim 60 was rejected as unpatentable under 35 U.S.C. § 103(a) over Koshimizu '373 in view of Collins, Wilbur and Koshimizu '687 as applied to claims 42 to 45, 50 to 53, 56 to 59, 61 and 63 to 71, and in further view of the Laermer reference.

Claim 60 depends from claim 42 as presented, and is therefore allowable for the same reasons as claim 42 as presented over the Koshimizu '373, Collins, Wilbur and Koshimizu '687 references, as explained above, since the fourth-level Laermer et al. reference does not cure the critical deficiencies of the primary, secondary and third-level references.

Accordingly, claims 42 to 45 and 47 to 71 are allowable for all of the above reasons.

CONCLUSION

In view of the foregoing, it is believed that the rejections have been obviated, and that claims 42 to 45 and 47 to 71 are allowable. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,
KENYON & KENYON

Dated: 8/9/2005 By: _____

Richard L. Mayer
(Reg. No. 22,490)
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646

1029448